

Patent
Attorney's Docket No. 1033292-004

Reasons to reconsider and withdraw restriction requirement

Applicants respectfully request the Patent Office to reconsider and to withdraw the restriction requirement for the following reasons. Under M.P.E.P § 803, a restriction is proper if the subject matter can be restricted into one of two or more claimed inventions, and these inventions are either independent (M.P.E.P § 806.04) or distinct (M.P.E.P § 806.05). However, the second element for a restriction requirement to be proper is that if the search and examination of an entire application can be made without serious burden, the examiner must examine the entire application on the merits, even though it includes claims to independent and distinct inventions. Additionally, under M.P.E.P § 816, “[t]he particular reasons relied on by the examiner for holding that the inventions are either independent or distinct should be concisely stated. A mere statement of conclusion is inadequate.”

Applicants respectfully assert that the inventions of Group I and Groups II (claims 6-10) and III (claims 11-16) should be rejoined and examined together. The inventions of Groups I-III relate to compositions or systems which use or comprise Gilsonite oil to facilitate the topical or transdermal administration of an agent. Accordingly, Groups I-III all share the same corresponding technical feature as to form a single inventive concept.

Thus, Applicants submit that all of pending claims 1-16 can be searched simultaneously, and that a duplicative search, with possibly inconsistent results, may occur if the restriction requirement is maintained. Applicants submit that any nominal burden placed upon the Examiner to search accordingly to determine the art relevant to Applicants’ overall invention is significantly outweighed by the public’s interest in not having to obtain and study many separate patents in order to have available all of the issued patent claims covering Applicants’ invention. The alternative is to proceed with the filing of multiple applications, each consisting of generally the same disclosure, and each being subjected to essentially the same search, perhaps by different Examiners on different occasions. This process would place an unnecessary burden on both the Patent and Trademark Office and on the Applicants.

Applicants respectfully request reconsideration of the restriction requirement, withdrawal of the election and rejoinder of the claims. Applicants have no intention of abandoning any non-elected subject matter and should it be necessary, Applicants expressly reserve the right to file one or more continuation and/or divisional applications directed to non-elected subject matter.


The Examiner is invited to contact the undersigned at the below-listed telephone number, if it is believed that prosecution of this application may be assisted thereby.

Respectfully submitted,

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